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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,368	04/12/2004	Steven A. Bogen	1159.1004-006	4846

21005 7590 11/02/2006

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EXAMINER

ALEXANDER, LYLE

ART UNIT PAPER NUMBER

1743

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/823,368

Applicant(s)

BOGEN ET AL.

Examiner

Lyle A. Alexander

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-8,10 and 12-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3,5-8,10 and 12-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3,5-8,10 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heidt et al (USP 5,089,229), Copland et al. (USP 5,654,200), Kerr et al. (USP 5,075,079) or Rogers et al. (USP 4,043,292) in view of Potter et al. (USP 5,819,842).

See the appropriate paragraphs of the 2/17/06 Office actions.

The 8/21/06 amendments have clarified the pending claim language with respect to the relative movement between the liquid dispenser and platform. The Office does not believe this language adds any new structural limitations. Other amendments of 8/21/06 add the structure of a liquid dispenser that includes an actuator positioned at a stationary liquid dispensing station. The newly claimed "actuator" has been read in light of the original specification as means to control the amount of fluid sample being delivered. Heidt et al (USP 5,089,229), Copland et al. (USP 5,654,200), Kerr et al. (USP 5,075,079) and Rogers et al. (USP 4,043,292) all teach means to control the amount of fluid dispensed and are indistinguishable from the instant claim language. Additionally, Copland et al. teach in the abstract " a reagent delivery actuator device" which is further indistinguishable from the instant claims.

Response to Arguments

Applicant's arguments filed 8/21/06 and 10/13/06 have been fully considered but they are not persuasive.

Applicants' state the 35 USC 103 rejections of record are untenable because Potter cannot be used, as this reference is "non-analogous art". The MPEP provides guidance in section 2141.01 as to what is considered analogous art. The court decided *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993); and *State Contracting & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003) (where the general scope of a reference is outside the pertinent field of endeavor, the reference may be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved).

The instant facts are the primary references are directed to the automated processing of slides encompassing all of the claimed elements except for an individual sensor beneath each slide to control each slides temperature independently. The Office consulted Potter who also teaches an apparatus for manipulation of biological samples on slides. Potter teaches an individual sensor below each slide that regulates the temperature of each individual slide. This is advantageous to gain the advantage of tailoring a precise temperature for an individual sample. The Office maintains the primary references and Potter are both concerned with the same problem—heating and manipulating biological samples. The Office maintains Potter is analogous art and the rejections of record are proper.

Applicants' also argue the rejection of record is directed to a different method of intended use. These remarks are not convincing because the method of intended use of an apparatus is of no patentable moment.

Applicants' state Heidt and Kerr do not require the heating control as described by Potter. These remarks are not convincing. Both Heidt and Kerr teach heating/incubating the slide samples. The Office used the motivation/advantages of the heating system of Potter to modify Heidt and Kerr.

Applicants' state it would be technically difficult make the combination of Rogers or Copeland in view of Potter. These remarks are not convincing because "difficulty of the combination" is not the criteria for making a combination under 35 USC 103. Rather, 35 USC 103 requires there is sufficient motivation to make the combination. The Office maintains there is sufficient motivation of record to make the combinations. The Office maintains the 35 USC 103 rejections of Rogers or Copeland in view of Potter are proper.

Applicants' discuss several types of tissue staining. These remarks are all directed to a method of intended use of the apparatus that are of no patentable moment with respect to the pending apparatus claims.

This is a RCE of applicant's earlier Application No. 10/823,368. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had

been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A. Alexander whose telephone number is 571-272-1254. The examiner can normally be reached on Monday, Wednesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1743

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lyle A Alexander
Primary Examiner
Art Unit 1743

A handwritten signature in black ink, appearing to be 'Lyle A. Alexander', written in a cursive style.